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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

TIV, BACKHEAN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/563,489
Filing Date: January 03, 2006
Appellant(s): LEDERER ET AL.

Ralph G. Fischer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/20/11 appealing from the Office action
mailed 12/17/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-11 have been cancelled.

Claims 12-31 are pending and rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Microsoft Outlook 2002 released date 5/31/01

Windows XP released date 10/01

US Publication Coppinger et al. 08-2004

2004/0158607

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Outlook 2002 released date of 5/31/01 in view of Windows XP released date 10/01 (see screen shot of Outlook 2002 installed on Windows XP OS system) in view of US Publication 2004/0158607 issued to Coppinger et al. (Coppinger).

As per claim 12, 18, 31 Outlook 2002 teaches a device for user-based processing of at least one electronic message(Outlook 2002 installed on computer), the device comprising: an e-mail client configured to receive at least one electronic message having a file attachment(Fig.2).

Windows XP teaches a user file system configured to store the file attachment(Fig.3); an attachment insertion unit configured to insert the replaced file attachment in a selected memory location in a file system(Fig.4); a message link insertion unit configured to insert a message link in the selected memory location, the message link referring to the electronic message(Fig.7,11; user can create a shortcut for the message and/or save electronic message); and a control unit configured to control the e-mail client, the attachment substitution unit, the message link insertion unit and the attachment insertion unit(Windows XP installed on a computer with a processor, memory, etc.).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 to include creating shortcuts to an email message and saving the shortcut as taught by Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002 and Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

Window Outlook 2002 and XP does not explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic

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message with a memory location link and link after user input is received that requires the file attachment to be saved and linked.

Coppinger explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link and link after user input is received that requires the file attachment to be saved and linked.

(Fig.1, 2; it is obvious that the file attachment is saved before linking).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Microsoft Outlook 2002 and XP to include an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link as taught by Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

Outlook 2002 in view of Windows XP in view of Coppinger does not explicitly teach the use of a save as and link command.

However taken into consideration, The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The

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Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. EXEMPLARY RATIONALES Exemplary rationales that may support a conclusion of obviousness include: (A) Combining prior art elements according to known methods to yield predictable results.

Outlook 2002 in view of Windows XP in view of Coppinger teaches the link and save as command as two separate commands(Windows XP, Figs.1-12, Coppinger, Figs.1,2).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 in view of Windows XP in view of Coppinger of having two separate commands for linking and saving to combine both of these command into one command, by combining the prior art elements would yield a predictable result which is when a user uses the save and link command, a file would be saved and linked at the same time, which save a user's time.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to save's a user's time by executing only one command to save and link a file as opposed to two separate commands.

As per claim 13, the method according to claim 12 wherein the user-selected memory location is a file and the second link is created and saved (Fig.10; shortcut is saved in the same folder as the attachment), such that the second link is displayed in the file, the second link configured to display the electronic message after the second

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link is actuated (Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 14, the method according to claim 13, wherein at least one file attachment has a file name that is changed when the at least one file attachment is saved(Fig.3,4,8; inherent, changing file name, operation in Microsoft XP).

As per claim 15, the method according to claim 14, wherein the second link is comprised of a name that is comprised of the changed file name(Fig.3,4,8; inherent operation in Microsoft XP).

As per claim 16, the method according to claim 12 wherein the electronic message is an e-mail of an SMTP e-mail client(Fig.1, Simple Mail Transport Protocol is commonly used in Outlook 2002 also supported by applicant's specification, page 1, line 21).

As per claim 17, the method according to claim 12, wherein the at least one file attachment is saved according to a defined role and/or in a set file structure(Fig.3, attachment can be saved in any folders and/or setting a specific folder for saving).

As per claim 19, the device according to claim 18 wherein the selected memory location is a file in the file system and the message link is created and saved such that the message link is displayed in that file, the same file as the file attachment, the message link configured to display the electronic message after the message link is actuated(Fig.10; shortcut is saved in the same folder as the attachment, Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 20, the device according to claim 19, wherein the message link is comprised of a file name of the inserted file attachment(Fig.9)

As per claim 21, the device according to claim 18, wherein the attachment insertion unit is configured to automatically file the replaced file attachment using a modified file name(Fig.3,4,8; inherent operation, changing file names, in Microsoft XP, Coppinger, Fig.1,2).

As per claim 22, the device according to claim 21, wherein the attachment insertion unit files the replaced file attachment according to a user-defined user define rule and/or a user-define file structure(Microsoft screenshot, Fig.3, Coppinger, Fig.2; para.0019). Motivation to combine set forth in claim 18.

As per claim 23, the method of claim 12 further comprising replacing the at least one file attachment with at least one attachment link in the electronic message(Coppinger, Figs.1,2). Motivation to combine set forth in claim 18.

As per claim 24, the method of claim 12 wherein the user-selected memory location is a hard disk of a telecommunications terminal or a memory accessible via a network(Fig.3, user can save on the network).

As per claim 25, the method of claim 12 wherein the link is a backlink(Fig.10, shortcut, as in Fig.3 of specification).

As per claim 26, the method of claim 12 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications

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terminals and networks(Coppinger, para.0015). Motivation to combine set forth in claim 18.

As per claim 27, the device of claim 18 wherein the message link is a backlink(Fig.10, shortcut, as in Fig.3 of specification).

As per claim 28, the device of claim 18 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications terminals and networks(Coppinger, para.0015). Motivation to combine set forth in claim 18.

As per claim 29, the device of claim 18 wherein the selected memory location is a file of a file system and the message link insertion unit is configured to insert a message link in the file-such that the message link is displayed in the same file along with the file attachment, the message link configured to display the electronic message after the message link is actuated(Fig.10; shortcut is saved in the same folder as the attachment, Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 30, The device of claim 18 wherein the message link insertion unit is comprised of a backlink generation apparatus (Fig.10, shortcut, as in Fig.3 of specification).

(10) Response to Argument

The applicant argues in substance,

a) the examiner has not proved obviousness under 35 USC 103,

b) the prior art does not teach, the creation of a link and save command,

In reply to a) and b); The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

And further, The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

As per claim 12, 18, 31 Outlook 2002 teaches a device for user-based processing of at least one electronic message(Outlook 2002 installed on computer), the device comprising: an e-mail client configured to receive at least one electronic message having a file attachment(Fig.2).

Windows XP teaches a user file system configured to store the file attachment(Fig.3); an attachment insertion unit configured to insert the replaced file attachment in a selected memory location in a file system(Fig.4); a message link insertion unit configured to insert a message link in the selected memory location, the message link referring to the electronic message(Fig.7,11; user can create a shortcut

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the message and/or save electronic message); and a control unit configured to control the e-mail client, the attachment substitution unit, the message link insertion unit and the attachment insertion unit(Windows XP installed on a computer with a processor, memory, etc.).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 to include creating shortcuts to an email message and saving the shortcut as taught by Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002 and Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

Window Outlook 2002 and XP does not explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link and link after user input is received that requires the file attachment to be saved and linked.

Coppinger explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link and link after user input is received that requires the file attachment to be saved and linked. (Fig.1, 2; inherently the file attachment is saved before linking).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Microsoft Outlook 2002 and XP to include an attachment substitution unit configured to replace a file attachment of a received

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electronic message with a memory location link as taught by Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

Outlook 2002 in view of Windows XP in view of Coppinger does not explicitly teach the use of a save as and link command.

However taken into consideration, The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. EXEMPLARY RATIONALES Exemplary rationales that may support a conclusion of obviousness include: (A) Combining prior art elements according to known methods to yield predictable results.

Outlook 2002 in view of Windows XP in view of Coppinger teaches the known methods of the link and save as command as two separate commands(Windows XP, Figs.1-12, Coppinger, Figs.1,2).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 in view of Windows XP in view of

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Coppinger of having two separate commands for linking and saving to combine both of these command into one command, by combining the prior art elements would yield a predictable result which is when a user uses the save and link command, a file would be saved and linked at the same time, which save a user's time.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to save's a user's time by executing only one command to save and link a file.

Therefore based upon *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007), the examiner has proved obviousness under 35 USC 103.

c) XP and Outlook utilized the claimed method,

In reply to c); Pertaining to whether the someone actually used the method of XP and Outlook, the applicant in essence is arguing non-statutory subject matter, e.g. a person doing the steps of XP and Outlook as claimed. XP and Outlook teaches the functionality of the claimed language, and it is not necessary for the examiner to provide evidence of whether a person uses the claimed method of XP and Outlook as this is non-statutory subject matter, therefore showing that XP and Outlook teaches the claimed method is sufficient .

d) the examiner has used hindsight reasoning,

In reply to d); In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction

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based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Evidence Appendix

Microsoft Outlook and Windows XP

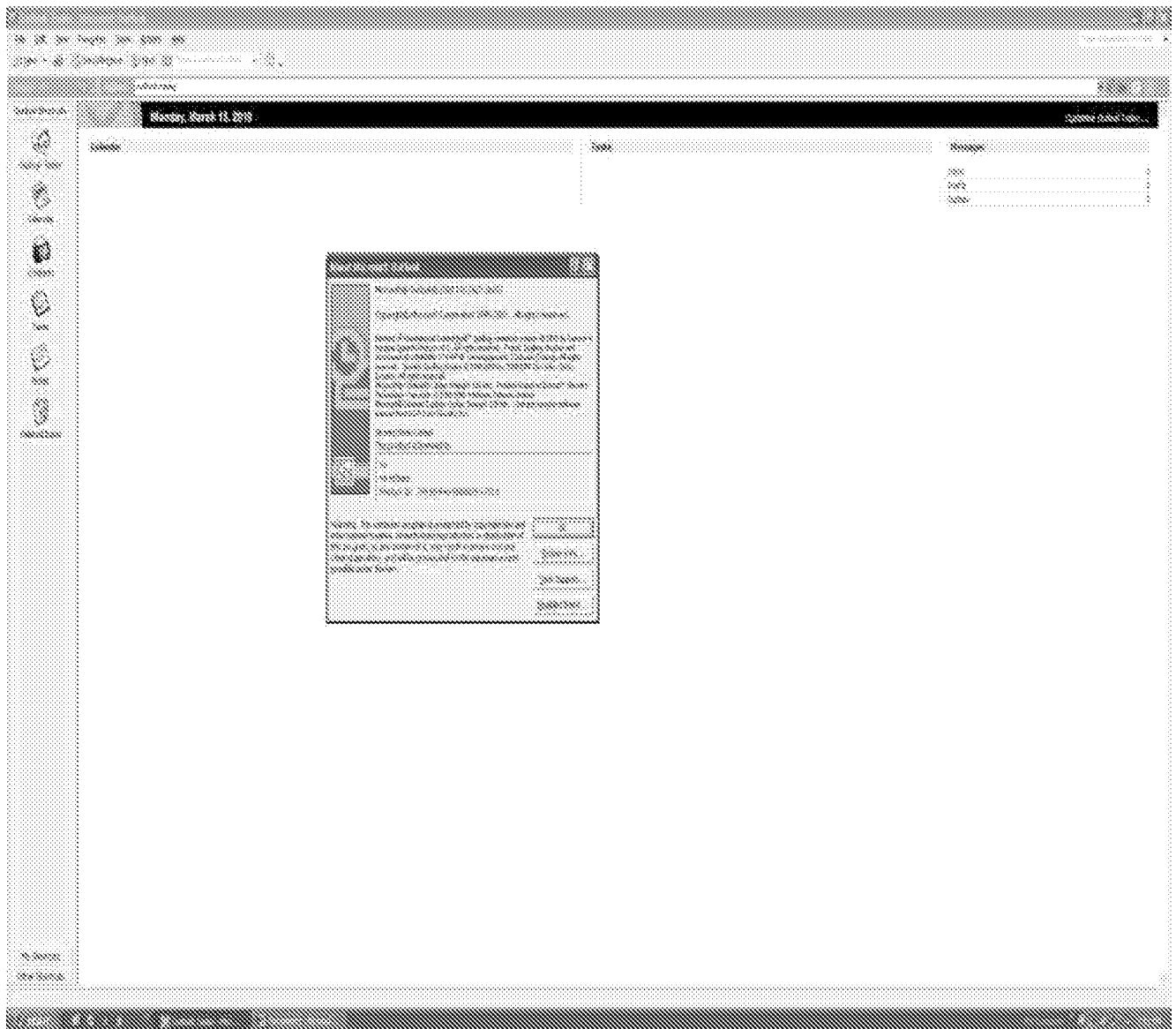


Figure 1

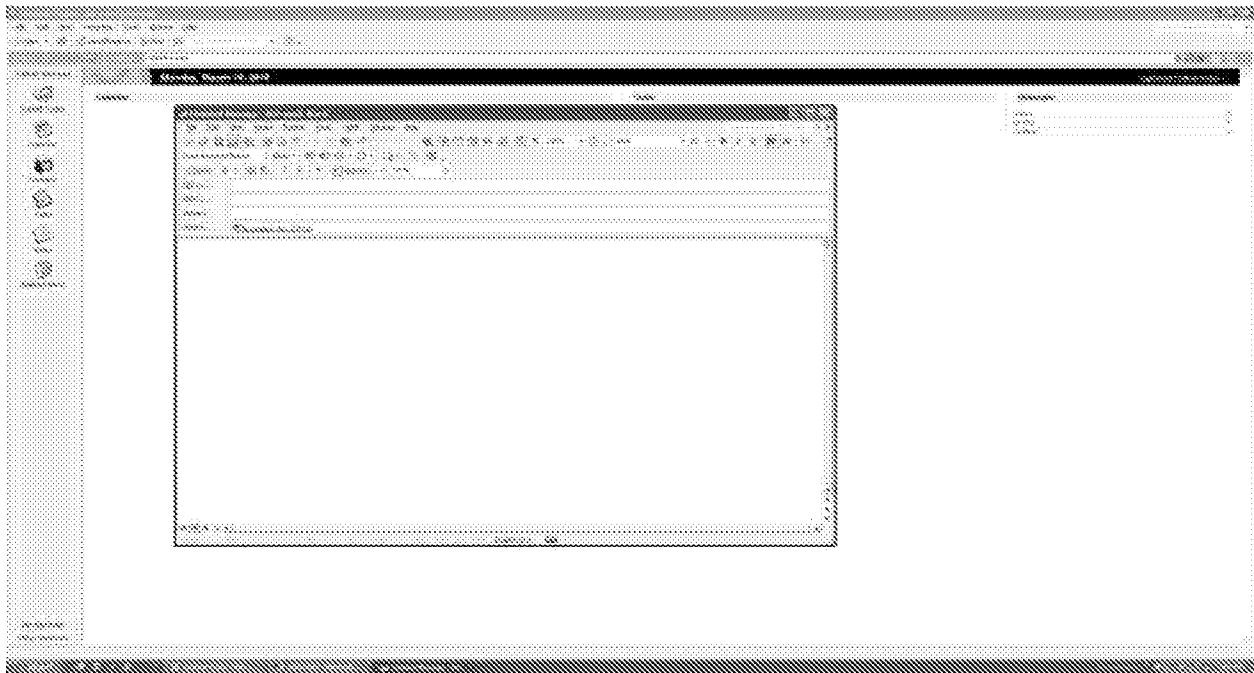


Figure2

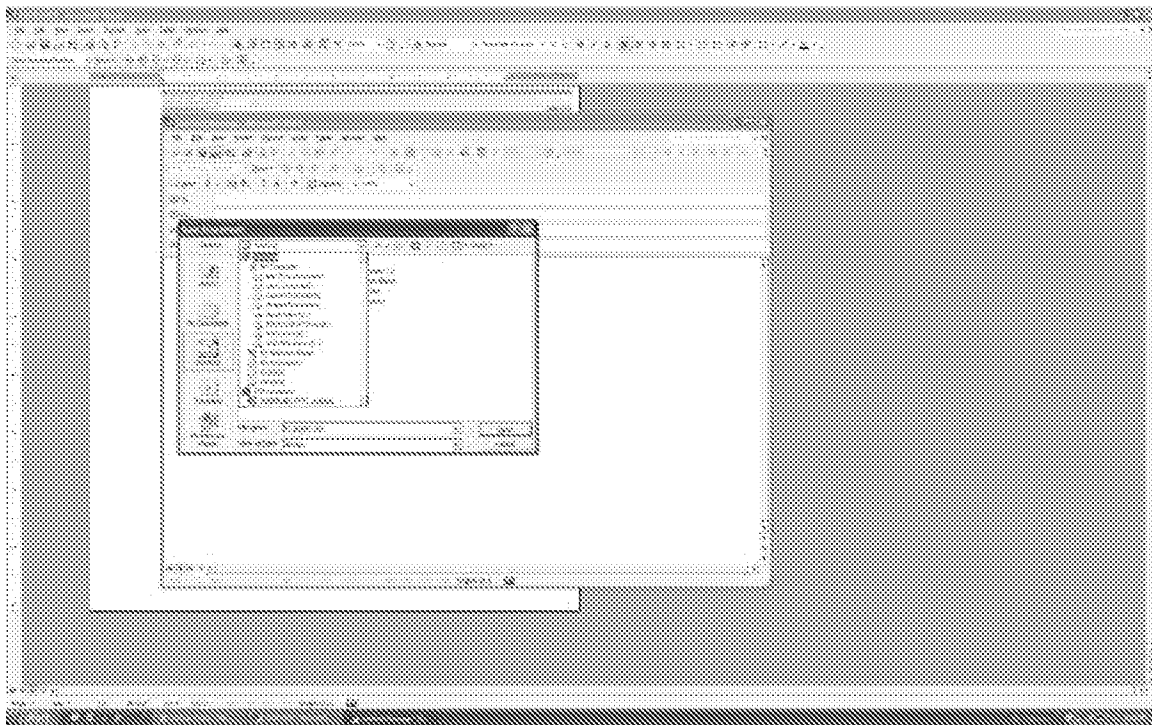


Figure 3

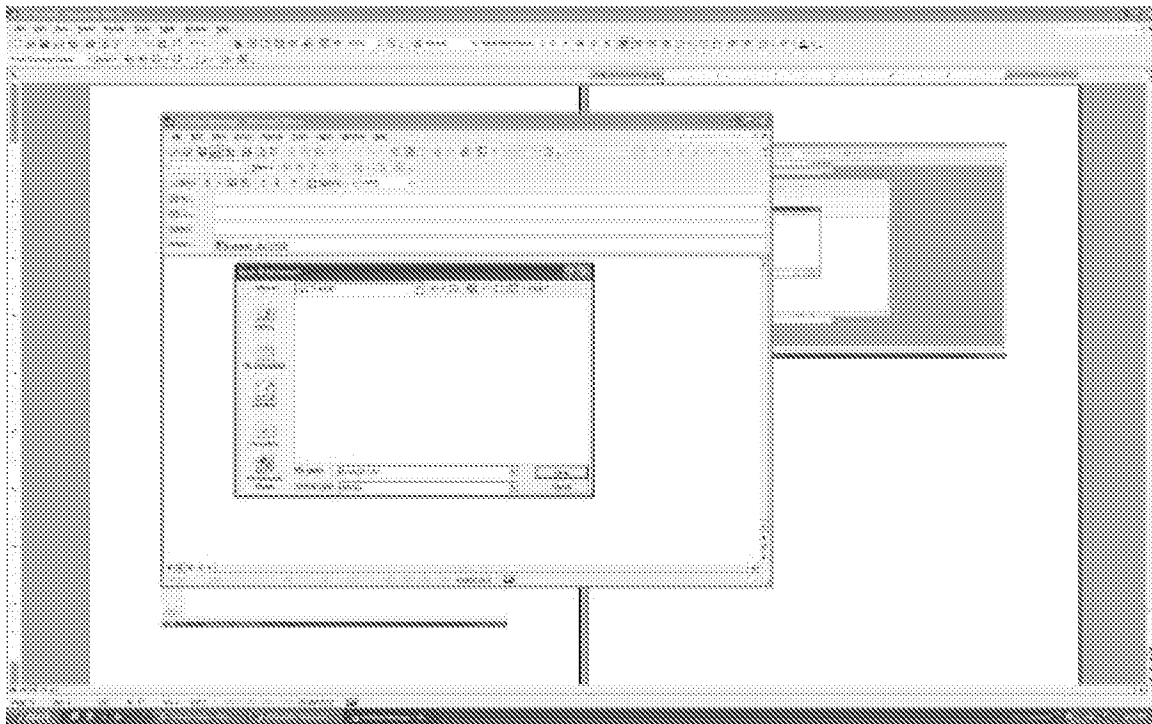


Figure 4

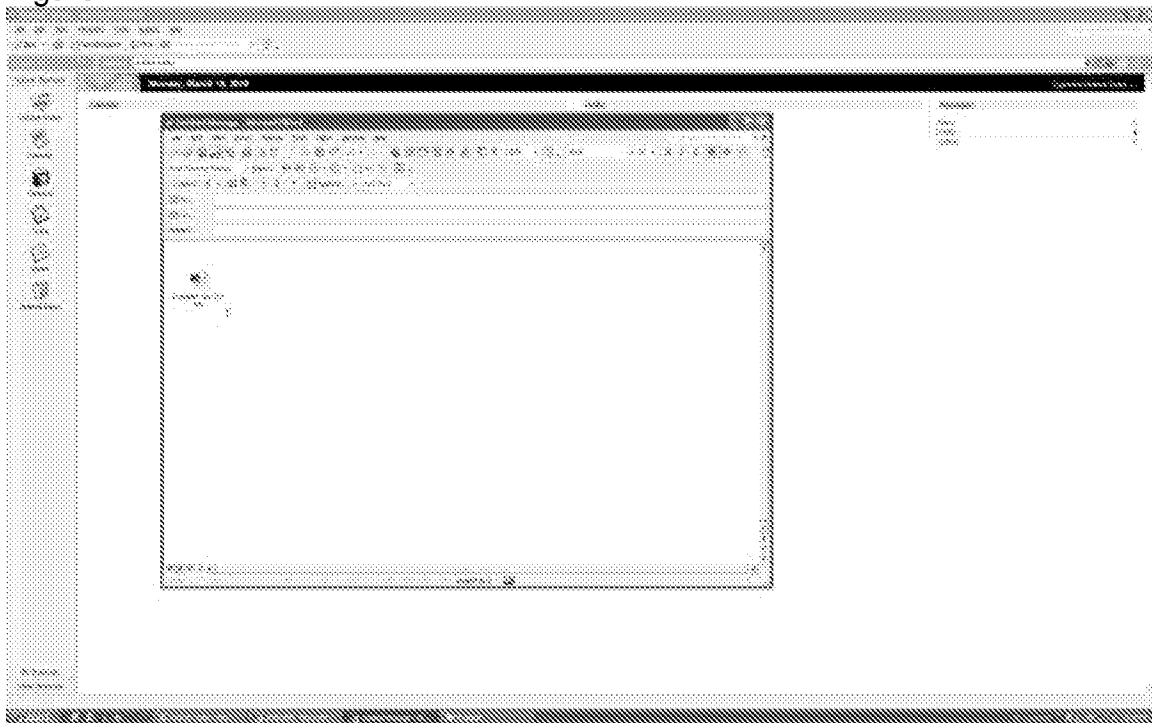


Figure 5

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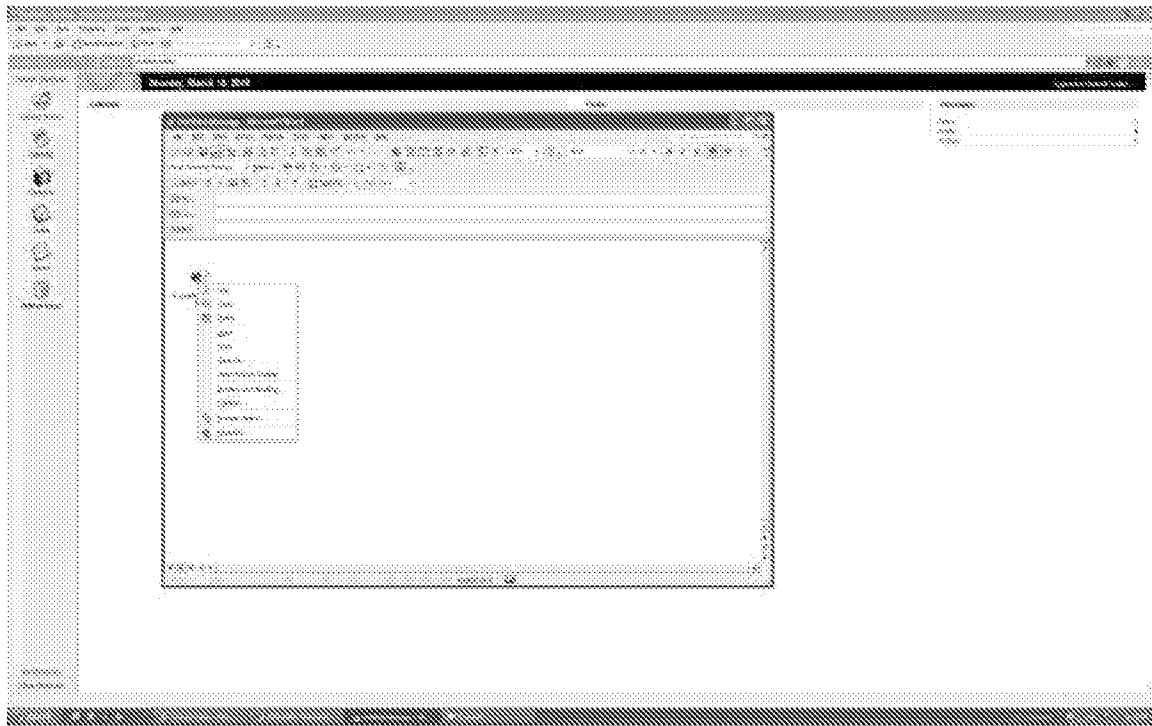


Figure 6

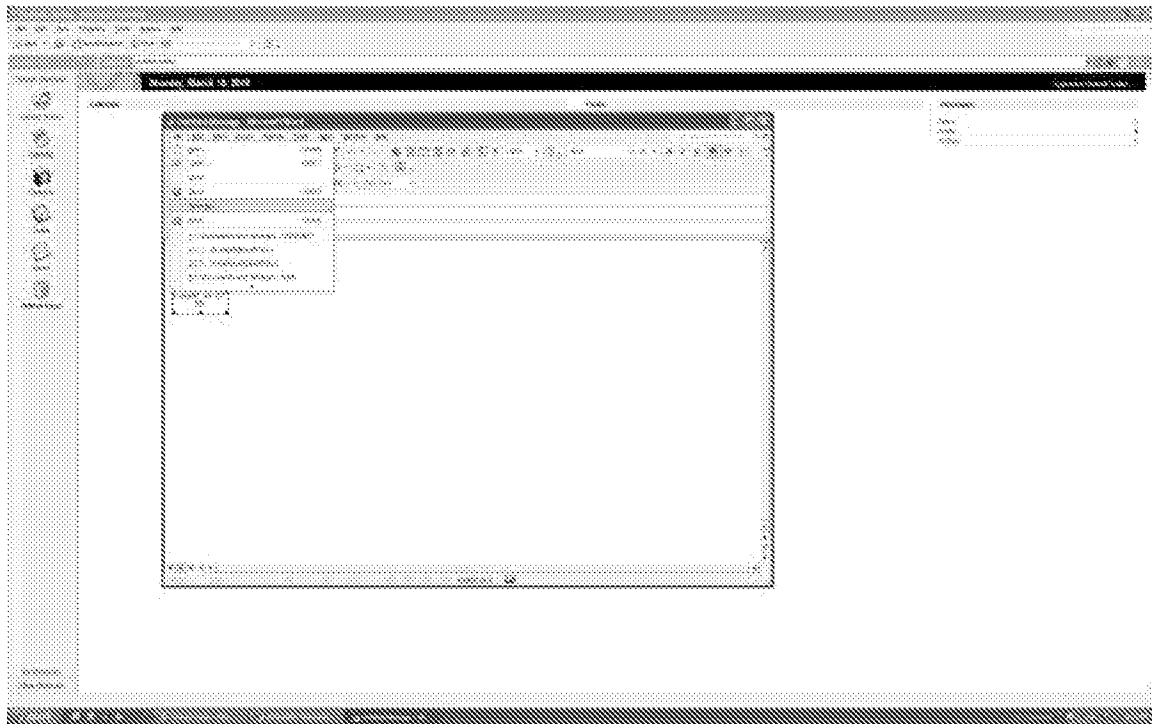


Figure 7

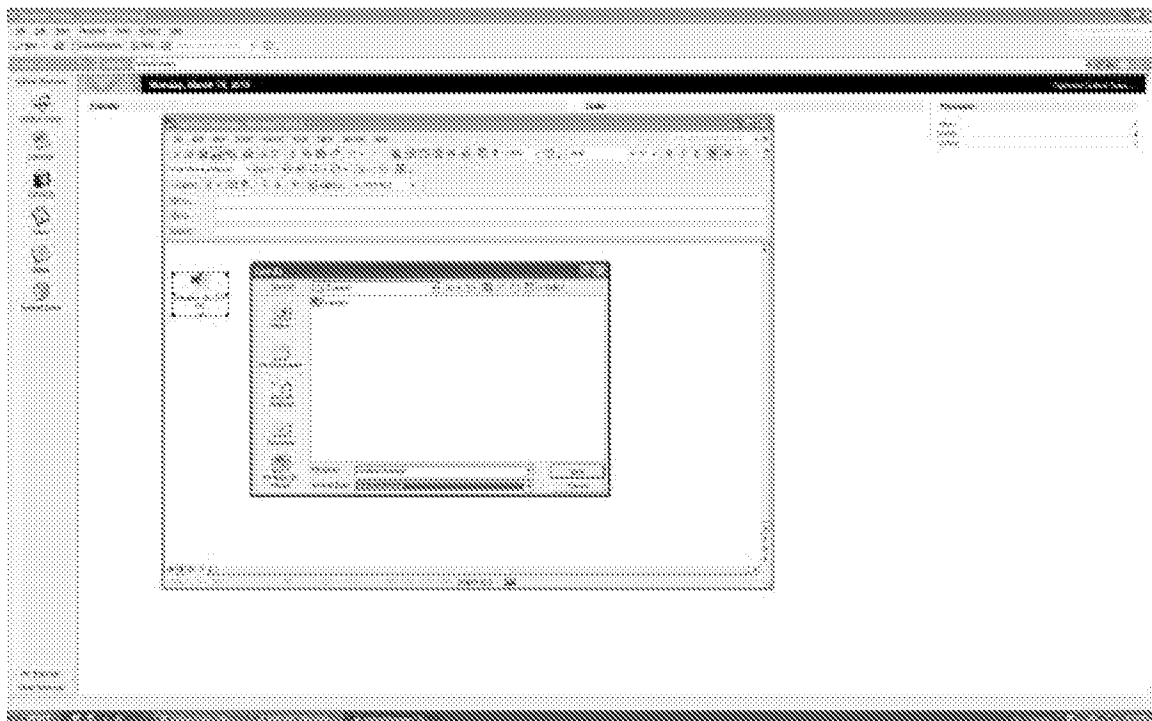


Figure 8

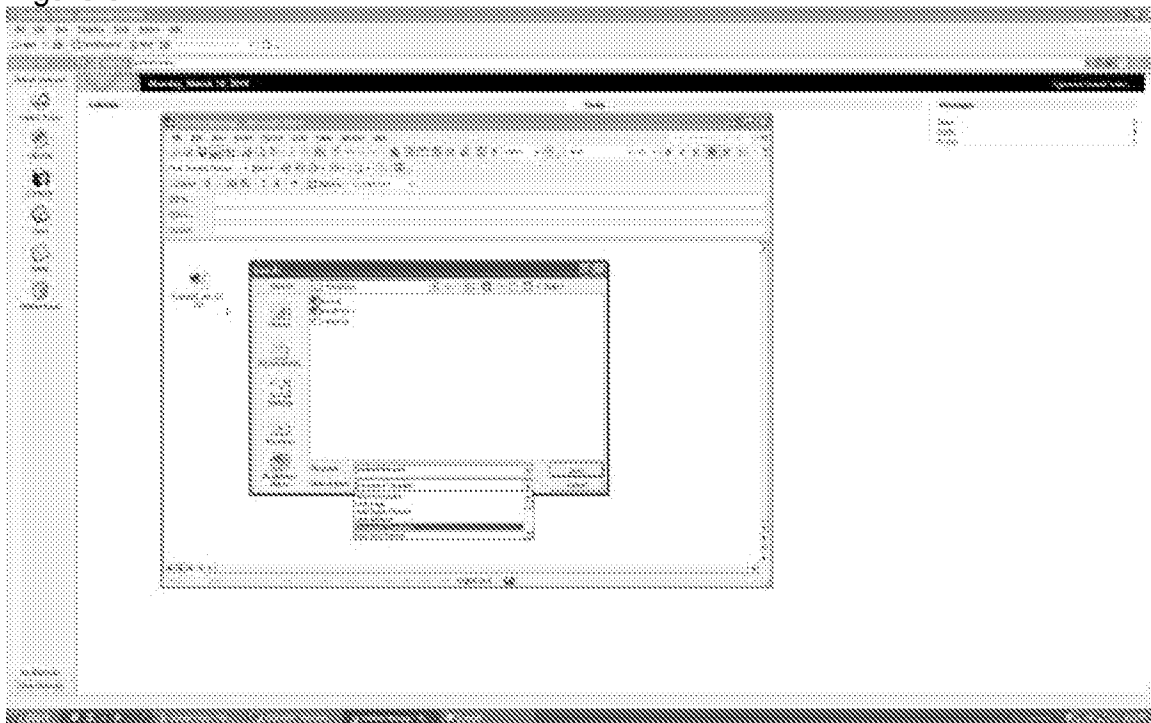


Figure 9

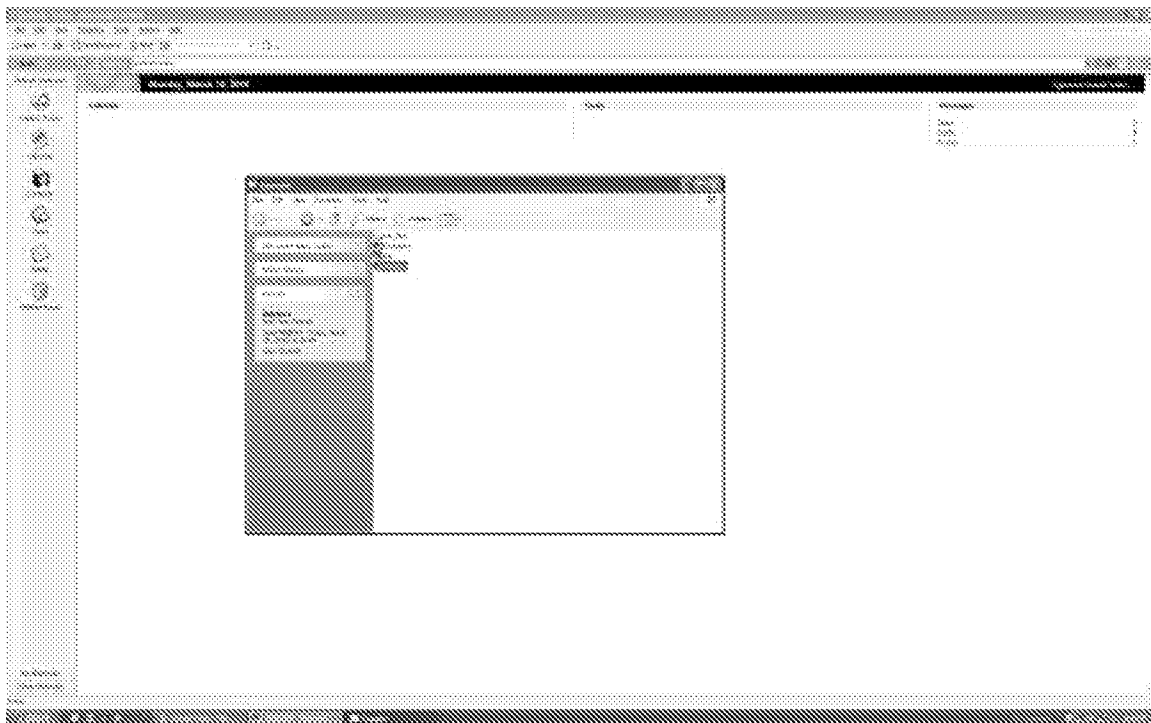


Figure 10

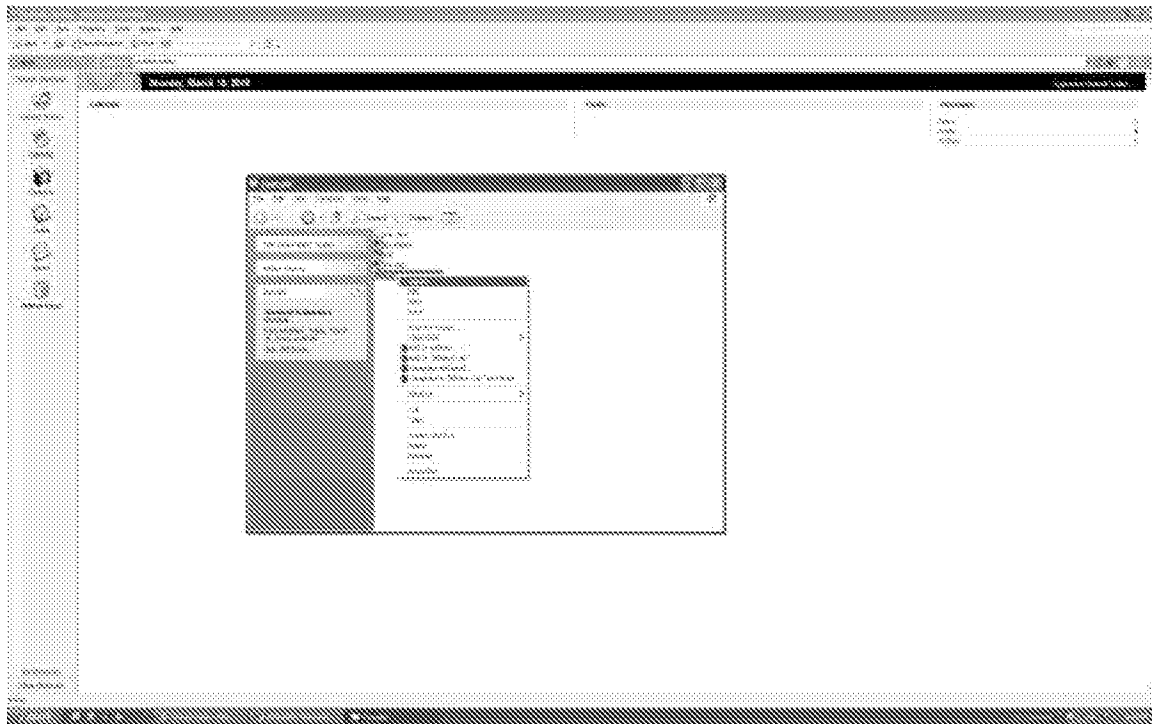


Figure 11

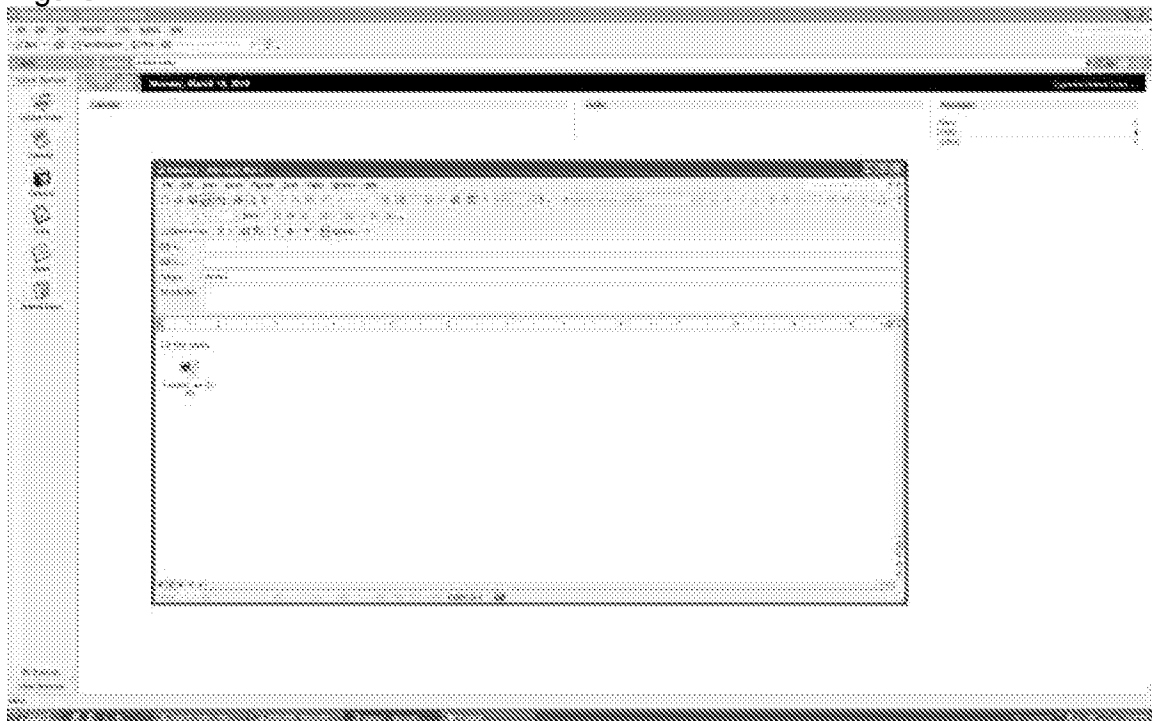


Figure 12

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Backhean Tiv/

Examiner, Art Unit 2451

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451

Conferees:

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451

/Rupal D. Dharia/

Supervisory Patent Examiner, Art Unit 2456